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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,315	02/09/2006	Ban Chin To	SCOTT USP4699	6117
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HAYES SOLOWAY P.C. 3450 E. SUNRISE DRIVE, SUITE 140 TUCSON, AZ 85718				
EXAMINER				
MAKIYA, DAVID J				
ART UNIT		PAPER NUMBER		
2885				
NOTIFICATION DATE		DELIVERY MODE		
02/18/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/501,315

Applicant(s)

TO, BAN CHIN

Examiner

David J. Makiya

Art Unit

2885

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-42, 44-48 and 50-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-42, 44-48 and 50-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/22/2009 has been entered.

Claim Objections

Claims 34 and 44 are objected to because of the following informalities: it is unclear as to how the fascia retainer is flush with the support surround if the device is pivoted. As shown in the applicant's instant Figure 2F, when the light is pivoted, the surfaces are no longer flush. The claims will be interpreted as best understood. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims **34-42, 44-48**, and **50-58** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kotovsky (US Patent 6,511,208) in view of Houplain (US Patent 4,763,231) and Caluori (US Patent 5,609,414).

With respect to claims 34, 41, and 50-56, Kotovsky teaches a light fitting having a front and a rear, the light fitting having a support surround 12 and a front fascia 24, and a pair of fascia retainers 20 for holding the front fascia in position in the support surround (Column 3, Lines 34-

39), the facia retainer enabling removal thereof from an installed position at the front of the light fitting (Figure 1), the light fitting further having a lamp retainer 24 and a lamp 55 wherein the lamp is retained by the lamp retainer (Figure 1), the front facia having a rear side and a front side (Figure 1), the front side of the facia being flush with a front surface of the support surround when in an installed position (Figure 1), and wherein the front facia is attached by the facia retainer to an intermediate member 22, the intermediate member being attached to the support surround (Column 4, Lines 34-47).

However, Kotovsky fails to teach the lamp being resiliently biased toward the rear side of the front facia such that the lamp may be moved backwards away from a recessed ledge of the rear side of the front facia or the facia retainer being a resilient spring clip.

Houplain teaches a light fitting comprising a support surround 1 and a front facia 6 and a facia retainer 8, the facia retainer being resilient for enabling removal thereof from an installed position (Figure 5) at the front of the light fitting by a generally translational movement (Figure 2; Column 2, Lines 36-51), the light fitting further having a lamp retainer 17 and a lamp 11 wherein the lamp is retained by the lamp retainer (Column 2, Lines 60-64), the front facia has a rear side and a front side (Figure 2), the lamp being resiliently biased (15; Column 2, Lines 54-63) toward the rear side of the front facia such that the lamp may be moved backwards away from a recessed ledge 17 of the rear side of the front facia (Column 3, Lines 3-4) that engages the perimeter of the lamp (Figure 5) to enable a finger or a tool to be engaged behind the ledge to facilitate removal of the front facia from the support surround (Column 2, Lines 36-60), in which the resilient biasing is provided by two helical springs 15 for biasing the lamp towards the front facia (Column 2, Lines 54-63), each extending from an end 16 of a lamp opposite a lens end 24

thereof to a lamp retainer 16 and from an electrical connector (12, 13, 14) to the lamp retainer (Column 2, Lines 54-63) and the support surround includes at least one spring arm 5 for holding the light fitting in place on a layer of the building material 2 (Figure 2).

Caluori teaches a light fitting having a front and a rear, the light fitting having an intermediate member 12 and a front facia 24, and a facia retainer 26 for holding the front facia in position in the support surround (Column 3, Lines 19-21), the facia retainer being resilient for enabling removal (Figure 2) thereof from an installed position (Figure 1) thereof by a generally translational movement (Figure 1; Column 1, Lines 15-20), the light fitting further having a lamp retainer 24 and a lamp 2 wherein the lamp is retained by the lamp retainer (Figure 1), the front facia having a rear side and a front side (Figure 1), the facia to enable a finger or a tool to be engaged behind a ledge (overlap of 24 past 16; Figure 1) to facilitate removal of the front facia from the support surround (Column 3, Lines 11-21 and Column 5, Lines 13-15), wherein the facia retainer comprises at least one spring clip (26; Column 3, Lines 11-21), and wherein the front facia is attached by the facia retainer to the intermediate member (Figure 1).

It would have been obvious and advantageous to one of ordinary skill in the art at the time of the invention to modify and reconstruct the light fitting by replacing the facia retainer of Kotovsky with the spring clips from the teachings of Caluori because the spring clips “prevent the fixture from dropping out of the opening” (Caluori; Column 2, Lines 1-5) and resiliently biasing the lamp from the teachings of Houplain because adding helical springs to resiliently bias the lamp toward the front facia because they “makes it possible to hold the lighting fixture 11 together with the support 6 by means of two springs 1” (Houplain; Column 2, Lines 54-63) to ensure the electrical contact of the lamp to the socket 12.

With respect to claim 35, Kotovsky teaches the light fitting in which the lamp retainer forms the front facia (Figure 1).

With respect to claim 36, Kotovsky teaches the light fitting in which the lamp retainer comprises a tube 67 extending axially in front of the lamp (Figure 11).

With respect to claims 37-40 and 45-48, Kotovsky in view of Houplain and Caluori teaches the light fitting as described above.

However, Kotovsky in view of Houplain and Caluori fails to teach a particular shape for the front facia or intermediate member to have a non-circular cross section.

It would have been obvious and advantageous to one of ordinary skill in the art at the time of the invention to modify and reconstruct the cross sectional shape of the front facia or intermediate member of Kotovsky in view of Houplain and Caluori with any shape, since it has been held by the courts that a change in shape or configuration, without any criticality, is nothing more than one of numerous shapes that one of ordinary skill in the art will find obvious to provide based on the suitability for the intended final application *In re Dailey*, 149 USPQ 47 (CCPA 1976) and a simple substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. -, 82 USPQ2d 1385. It appears that the disclosed device would perform equally well shaped as disclosed by Kotovsky.

With respect to claim 42, Kotovsky teaches a light fitting having a front and a rear, the light fitting having a support surround 12 and a front facia 14, and a pair of facia retainers 20 for holding the front facia in position in the support surround (Column 3, Lines 34-39), the facia retainer enabling removal thereof from an installed position at the front of the light fitting

(Figure 1), the light fitting further having a lamp retainer 24 and a lamp 55 wherein the lamp is retained by the lamp retainer (Figure 1), the front facia having a rear side and a front side (Figure 1), the front side of the facia being flush with a front surface of the support surround when in an installed position (Figure 1), and wherein the front facia is directly retained by the facia retainer to the support surround (Column 4, Lines 34-47).

However, Kotovsky fails to teach the lamp being resiliently biased toward the rear side of the front facia such that the lamp may be moved backwards away from a recessed ledge of the rear side of the front facia or the facia retainer being a resilient spring clip.

Houplain teaches a light fitting comprising a support surround 1 and a front facia 6 and a facia retainer 8, the facia retainer being resilient for enabling removal thereof from an installed position (Figure 5) at the front of the light fitting by a generally translational movement (Figure 2; Column 2, Lines 36-51), the light fitting further having a lamp retainer 17 and a lamp 11 wherein the lamp is retained by the lamp retainer (Column 2, Lines 60-64), the front facia has a rear side and a front side (Figure 2), the lamp being resiliently biased (15; Column 2, Lines 54-63) toward the rear side of the front facia such that the lamp may be moved backwards away from a recessed ledge 17 of the rear side of the front facia (Column 3, Lines 3-4) that engages the perimeter of the lamp (Figure 5) to enable a finger or a tool to be engaged behind the ledge to facilitate removal of the front facia from the support surround (Column 2, Lines 36-60), in which the resilient biasing is provided by two helical springs 15 for biasing the lamp towards the front facia (Column 2, Lines 54-63), each extending from an end 16 of a lamp opposite a lens end 24 thereof to a lamp retainer 16 and from an electrical connector (12, 13, 14) to the lamp retainer

(Column 2, Lines 54-63) and the support surround includes at least one spring arm 5 for holding the light fitting in place on a layer of the building material 2 (Figure 2).

Caluori teaches a light fitting having a front and a rear, the light fitting having an intermediate member 12 and a front facia 24, and a facia retainer 26 for holding the front facia in position in the support surround (Column 3, Lines 19-21), the facia retainer being resilient for enabling removal (Figure 2) thereof from an installed position (Figure 1) thereof by a generally translational movement (Figure 1; Column 1, Lines 15-20), the light fitting further having a lamp retainer 24 and a lamp 2 wherein the lamp is retained by the lamp retainer (Figure 1), the front facia having a rear side and a front side (Figure 1), the facia to enable a finger or a tool to be engaged behind a ledge (overlap of 24 past 16; Figure 1) to facilitate removal of the front facia from the support surround (Column 3, Lines 11-21 and Column 5, Lines 13-15), wherein the facia retainer comprises at least one spring clip (26; Column 3, Lines 11-21), and wherein the front facia is attached by the facia retainer to the intermediate member (Figure 1).

It would have been obvious and advantageous to one of ordinary skill in the art at the time of the invention to modify and reconstruct the light fitting by replacing the facia retainer of Kotovsky with the spring clips from the teachings of Caluori because the spring clips “prevent the fixture from dropping out of the opening” (Caluori; Column 2, Lines 1-5) and resiliently biasing the lamp from the teachings of Houplain because adding helical springs to resiliently bias the lamp toward the front facia because they “makes it possible to hold the lighting fixture 11 together with the support 6 by means of two springs 1” (Houplain; Column 2, Lines 54-63) to ensure the electrical contact of the lamp to the socket 12.

With respect to claim 44, Kotovsky teaches the light fitting in which the intermediate member is pivotally coupled to the support surround (Column 4, Lines 34-47).

With respect to claim 57, Kotovsky teaches the light fitting which includes a lamp, the lamp having a flat front surface (Figures 1, 11).

With respect to claim 58, Kotovsky teaches the light fitting which comprises a downlighter (Figure 1).

Response to Arguments

Applicant's arguments with respect to claims 34-42, 44-48, and 50-58 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Ng (US Patent 6,779,908) and Kristofek (US Patent 4,475,147) both teach light fittings with a front fascia and a support surround with the front surfaces being flush.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Makiya whose telephone number is (571) 272-2273. The examiner can normally be reached on Monday-Friday 7:30am - 4:00pm (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk (James) Lee can be reached on (571) 272-7044. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DJM/ 2/5/2010

/Jacob Y Choi/
Primary Examiner, Art Unit 2885